

RECEIVED
CENTRAL FAX CENTER

SEP 07 2006

Remarks

This is a complete response to the Office Action mailed July 7, 2006. These remarks are proper, do not include new matter, are not narrowing in view of a prior art rejection, do not require the Examiner to perform additional searching, and explain why all claims are in condition for allowance.

In the absence of the requested reconsideration, these remarks further serve to explain why this case is again not in condition for appeal.

Rejection Under Section 112 First Paragraph

Claims 1-13, 18, 19, and 21-24 stand rejected for lack of written description support for the recited phrases *continuous convex*, *frusto-conical*, and *semi-spherical*. This rejection is respectfully traversed.

Regarding *continuous convex*, Applicant has repeatedly stated that the present embodiments as claimed are distinguishable over the art of record which do not disclose, teach or suggest a diaphragm configured for damping both high and low frequency vibrations:

In the expanded mode the chamber is pressurized to fill the chamber to a working volume. In an expanded profile of the filled chamber, the diaphragm 104 is taut to support the load and allow transmission of low frequency vibration through the fluid isolator assembly 102 and pressure chamber 106. In the embodiment described, the system or apparatus can be designed to provide only a low natural frequency for the fluid damping system or spring which provides similar spring rates in both horizontal and vertical directions and provides a higher frequency viscoelastic damping for vibration bypassing chamber 106 by traveling on the taut surface of the diaphragm 104.
(paragraph [0015], emphasis added)

FIG. 1 clearly shows the taut surface of the diaphragm 104 defines a *continuous convex* surface, as do FIGS. 3 and 4 clearly show the taut surface of the diaphragm 104-1 defines a *continuous convex* surface. Applicant added the *continuous convex* language to more particularly point out and distinctly claim the present embodiments over the rolling convolution type gas seal 86 of Gertel '269. Contrary to the claimed embodiments, the rolling convolution type gas seal 86 of Gertel '269 defines a concave central membrane surrounded by an annular lateral displacement portion, specifically to make it not taut in order to *reduce* its horizontal stiffness:

In this continuation-in-part application, however, the piston 81, FIG. 5 has a chamber 82 in which resides resilient vibration damper unit 84. Piston 81 is received by rolling convolution type gas seal 86 within housing 88...Now, when a force $F_{sub.1}$ such as a vibration as shown at 110 is transmitted directly to table top 108 (or the load support interface) in any direction except along vertical axis 18, vibration damper 84 translates and rocks or pivots in the direction shown by arrow 112 about a horizontal axis transverse to axis 18 thereby reducing the horizontal stiffness of the gas spring.
(Gertel '269, col. 5 lines 21-38, emphasis added)

Compliance with the written description requirement is a question of fact which must be resolved on a case-by-case basis. *Vas-Cath, Inc. v. Mahurkar*, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Here, the skilled artisan viewing originally filed FIGS. 1, 3, and 4 and the descriptions thereof ("taut diaphragm surface") would reasonably conclude that Applicant had possession of the present embodiments in terms of the recited *continuous convex surface* feature as claimed.

Reconsideration and withdrawal of the present rejection of claims 1, 10, 18, and 21 and the claims depending therefrom are respectfully requested.

Regarding *frusto-conical*, the specification clearly discloses the sealed end of the diaphragm 104 as being cylindrical:

The ridge portion 138 of the diaphragm 104-1 is clamped or secured between the rigid base plate 134 and a rim portion 139 of ring 140 which forms a cylindrical cavity 142.
(paragraph [0017], emphasis added)

Additionally, originally filed FIGS. 3 and 4 and the descriptions thereof clearly show embodiments wherein the cross-sectional upstanding sides of the diaphragm 104-1 extending from the sealed end define non-parallel surfaces directed toward each other, defining a truncated conical shape. Accordingly, the skilled artisan viewing originally filed FIGS. 3 and 4 and the descriptions thereof would reasonably conclude that Applicant had possession of the present embodiments in terms of the recited *frusto-conical* feature as claimed.

Reconsideration and withdrawal of the present rejection of claims 1, 10, 18, and 21 and the claims depending therefrom are respectfully requested.

Regarding *semi-spherical*, as discussed above there is written description support for the diaphragm of the present embodiments being circular at its sealed end. Originally filed FIG. 1 and the descriptions thereof clearly show embodiments wherein the cross-sectional upstanding sides of the diaphragm 104 extending from the sealed end define a hemispherical shape. Accordingly, the skilled artisan viewing originally filed FIG. 1 and the descriptions thereof would reasonably conclude that Applicant had possession of the present embodiments in terms of the recited *semi-spherical* feature as claimed. Reconsideration and withdrawal of the present rejection of claims 1, 10, 18, and 21 and the claims depending

therefrom are respectfully requested.

Rejection Under Section 103

Claims 1-13, 18, 19, and 21-24 stand rejected as being unpatentable over Gertel '269. This rejection is respectfully traversed.

The Examiner has not substantiated a *prima facie* case of obviousness in the record. Applicant agrees with the Examiner to the extent that that Gertel '269 does not disclose or suggest the *continuous convex* surface of the diaphragm as recited by independent claims 1, 10, 18, and 21. However, the Examiner's assertion that by a mere design choice the skilled artisan would modify Gertel '269 to arrive at the present embodiments as claimed is reversible error.

This statement by the Examiner is incorrect: "There is no support for the criticality of the shape in the specification." (Office Action of 7/7/2006, pg. 3) Actually, Applicant has repeatedly explained that the taut surface, structurally claimed as being a *continuous convex* surface, imparts the necessary lateral stiffness to damp both high and low frequency vibrations (see Applicant's Response of 4/26/2006, pg. 9; Applicant's Pre-Brief Panel Request of 10/14/2005, ppg. 3-5; Applicant's Response of 9/14/2005, ppg. 11-14; Applicant's Response of 3/29/2005, ppg. 11-12).

The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the rejected claims is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. &

Inter. 1984). Here, Gertel '269 teaches away from the *continuous convex* surface in order to achieve reduced lateral stiffness. There is absolutely no motivation from Gertel '269 to modify the rolling convolution type gas seal 86 to arrive at the present embodiments as claimed.

Accordingly, the Examiner has failed to substantiate a *prima facie* case of obviousness because the cited reference does not teach or suggest all the features of the independent claims, and because there is no objective evidence either within the cited reference or the knowledge of a skilled artisan, absent an improper hindsight reconstruction, to motivate a skilled artisan to modify the cited reference to arrive at the present embodiments as claimed. Reconsideration and withdrawal of the rejection of claims 1, 10, 18 and 21 and the claims depending therefrom are respectfully requested.

Absent the requested reconsideration, a Pre-Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of obviousness. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Only a travesty in equities would require Applicant to proceed to appeal on a rejection lacking a substantiated *prima facie* case of obviousness. Accordingly, this case is not in condition for appeal due to the unresolved factual issues that the Examiner has failed to make the requisite evidentiary showing in the record substantiating a *prima facie* case of obviousness in regards to the cited references providing the all-elements and motivation prongs of the *prima facie* case.

RECEIVED
CENTRAL FAX CENTER

SEP 07 2006

Conclusion

This is a complete response to the Office Action mailed July 7, 2006. Applicant respectfully requests that the Examiner pass all of the pending claims to issuance.

Applicant has submitted herewith another request for a first telephone interview to be held after such time the Examiner has fully considered this Amendment but before the next action on the merits, if it is determined that all claims are not in condition for allowance.

The telephone interview is necessary to clarify the patentable distinction of the present embodiments as claimed over the art of record, in view of the erroneous characterizations by the Examiner that have unnecessarily prolonged the prosecution of this case. The Examiner is invited to contact the below signed Attorney should any questions arise concerning this response or request for interview.

Respectfully submitted,

By: 

Mitchell K. McCarthy, Registration No. 38,794
Randall K. McCarthy, Registration No. 39,297
Fellers, Snider, Blankenship, Bailey and Tippens
100 N. Broadway, Suite 1700
Oklahoma City, Oklahoma 73102
Telephone: (405) 232-0621
Facsimile: (405) 232-9659
Customer No. 33900